

### **Remarks**

This is responsive to the Office Action mailed November 26, 2007. The amendments do not contain new matter and without prejudice serve to more particularly point out and distinctly claim that which is patentable.

Support for the subject matter of new claims 34-36 can be found at least in the specification at page 7 lines 2-4 and the subject matter of claims 11-14, 22, 23, 28, and 31.

Support for the subject matter of new claim 37 can be found at least in claim 1 as previously presented.

Support for the subject matter of new claim 38 can be found at least in the specification at page 5 lines 16-18.

### **Rejection Under 35 U.S.C. 112**

Claims 9-15 stand rejected for an alleged written description deficiency in regard to the featured "pocket-size enclosure." Applicant has deleted the disputed language from claim 9 to obviate the rejection, and therefore respectfully requests withdrawal of the rejection.

### **Rejections Under 35 U.S.C. 103(a)**

#### **1. Claims 1-5, 8, 16-21, and 23-32**

Claims 1-5, 8, 16-21, and 23-32 stand rejected as being unpatentable over Chung '963 in view of Downs '618.

Claim 1

Applicant has amended independent claim 1 to more particularly feature the access instructions, which define the authorized usage of the entertainment media, being written either before or after the entertainment media is stored to the digital storage module.

In substantiating obviousness the Office is obligated to factually consider all the differences between what is claimed and what is disclosed by the cited references.<sup>1</sup> The present embodiments as disclosed and claimed contemplate being able to store the access instructions to the digital storage module at a different time than when the entertainment media is stored to the digital storage module. The digital storage module of the claimed embodiments has the requisite on-board intelligence via the controller 56 and communication interface 52 to store and execute the access instructions independently of executing the entertainment media. That makes it possible to pre-record the entertainment media to a digital storage module before the access instructions are even defined, much less stored, thereby significantly reducing the vending time for a fully programmed digital storage module from a point of purchase system.<sup>2</sup>

Applicant agrees with the Office to the extent that Chung '963 does not teach or suggest encoding the digital storage module with access instructions defining prescribed usage conditions.<sup>3</sup> Downs '618 only discloses and suggests embedding digital code in the entertainment media that defines the Usage Conditions.<sup>4</sup> The skilled artisan readily understands that embedded code is stored simultaneously with the Content to which it is embedded, in contravention to the claimed embodiments.

---

<sup>1</sup> *Graham v. John Deere Co.*, 388 US 1 (1966).

<sup>2</sup> See, for example, specification pg. 5 lines 16-18.

<sup>3</sup> Office Action of 11/26/2007, pg. 5 lines 3-6.

<sup>4</sup> See, for example, Downs '618 col. 7 lines 41-65; col. 11 lines 49-54; col. 21 line 60 to col. 22 line 15.

Thus, Chung '963, Downs '618, and all other art of record do not teach or suggest, neither alone nor in combination, *either before the storing the entertainment media step begins or after the storing the entertainment media step is completed, storing access instructions in the memory...* as featured by the language of claim 1. Therefore, there is lacking in the record the requisite evidence that the cited references include all the recited features of independent claim 1 to substantiate obviousness.<sup>5</sup> There is also lacking in the record any evidence that the skilled artisan, having knowledge of the cited references, would find it obvious to modify and combine them in order to arrive at the present embodiments as claimed.<sup>6</sup>

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 and the claims depending therefrom in view of the clarifying amendments to claim 1.

#### Claim 16

Applicant has amended independent claim 16 to more particularly feature storing the entertainment media in a selected one of a plurality of different communication formats, for playback by a common consumer-industry digital format player that is non-preformatted in relation to respecting usage rights and employs the selected data communication format.

In substantiating obviousness the Office is obligated to factually consider all the differences between what is claimed and what is disclosed by the cited references.<sup>7</sup> The present embodiments as disclosed and claimed contemplate being able to store the access instructions to the digital storage module in a variety of

---

<sup>5</sup> Examination Guidelines for Determining Obviousness in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, FR 57526

<sup>6</sup> *Id.*

<sup>7</sup> Note 1.

communication formats, providing freedom from the constraints of only being able to playback the entertainment media via pre-defined and pre-formatted end-user devices.<sup>8</sup>

Again, Applicant agrees with the Office to the extent that Chung ‘963 does not teach or suggest encoding the digital storage module with access instructions defining prescribed usage conditions as recited by claim 16.<sup>9</sup> Downs ‘618 only discloses and suggests playback of the Content via pre-defined and pre-formatted “compliant” End User Devices 109,<sup>10</sup> in contravention to the subject matter of claim 16.

Thus, Chung ‘963, Downs ‘618, and all other art of record do not teach or suggest, neither alone nor in combination, *stores user-selected entertainment media...according to a selected one of a plurality of different data communication formats...for playback...by a common consumer-industry digital format player device that is non-preformatted in relation to respecting...usage rights...* as featured by the language of claim 16. Therefore, there is lacking in the record the requisite evidence that the cited references include all the recited features of independent claim 16 to substantiate obviousness.<sup>11</sup> There is also lacking in the record any evidence that the skilled artisan, having knowledge of the cited references, would find it obvious to modify and combine them in order to arrive at the present embodiments as claimed.<sup>12</sup>

---

<sup>8</sup> See, for example, specification pg. 4 lines 13-16; pg. 14 lines 26-28; pg. 15 lines 10-14.

<sup>9</sup> Office Action of 11/26/2007, pg. 5 lines 3-6.

<sup>10</sup> See, for example, Downs ‘618 col. 7 lines 2-5; col. 7 lines 48-52; col. 11 lines 30-33.

<sup>11</sup> Note 5.

<sup>12</sup> *Id.*

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 16 and the claims depending therefrom in view of the clarifying amendments to claim 16.

#### Claim 28

Claim 28 depends from independent claim 9. Applicant has amended independent claim 9 to more particularly feature storing the access instructions separately from the entertainment media, such that they are not embedded in the entertainment media. As discussed above in the discussion of claim 1, Downs '618 only discloses and suggests embedding the digital code that defines the Usage Conditions in the Content, in contravention to the subject matter of claim 16.

Thus, Chung '963, Downs '618, and all other art of record do not teach or suggest, neither alone nor in combination, *store access instructions separately from the entertainment media...such that the access instructions are not embedded in the entertainment media...* as featured by the language of claim 9. Therefore, there is lacking in the record the requisite evidence that the cited references include all the recited features of independent claim 9 to substantiate obviousness.<sup>13</sup> There is also lacking in the record any evidence that the skilled artisan, having knowledge of the cited references, would find it obvious to modify and combine them in order to arrive at the present embodiments as claimed.<sup>14</sup> Claim 28 is allowable at least because it depends from an allowable independent claim and recites additional features.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 28 in view of the clarifying amendments to claim 9.

---

<sup>13</sup> Note 5.

<sup>14</sup> *Id.*

## 2. Claim 22

Claim 22 stands rejected as allegedly being unpatentable over Chung '963 and Downs '618 and further in view of Gibson '596.

As set forth above in the discussion of claim 1, Chung '963 and Downs '618 do not substantiate obviousness because they do not include all the recited features of claim 1. Gibson '596 and all other art of record do not cure the deficiency of Chung '963 and Downs '618 in this regard. Thus, claim 22 is allowable at least for the reason that it depends from an allowable independent claim and recites additional features. Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 22.

## 3. Claims 9, 10, and 15

Claims 9, 10, and 15 stand rejected as allegedly being unpatentable over Chung '963 in view of Katayama '212 and Downs '618.

As set forth in the discussion above for claim 28, Chung '963 and Downs '618 do not teach or suggest storing the access instructions separately from the entertainment media, such that they are not embedded in the entertainment media, in contravention to the subject matter of claim 9. Katayama '212, like Chung '963, does not teach or suggest storing digital code to protect usage rights and thereby fails to cure the deficiency of Chung '963 and Downs '618 in this regard.

Thus, Chung '963, Downs '618, and Katayama '212 and all other art of record do not teach or suggest, neither alone nor in combination, *store access instructions separately from the entertainment media...such that the access instructions are not*

*embedded in the entertainment media...* as featured by the language of claim 9.

Therefore, there is lacking in the record the requisite evidence that the cited references include all the recited features of independent claim 9 to substantiate obviousness.<sup>15</sup> There is also lacking in the record any evidence that the skilled artisan, having knowledge of the cited references, would find it obvious to modify and combine them in order to arrive at the present embodiments as claimed.<sup>16</sup>

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 9 and the claims depending therefrom in view of the clarifying amendments to claim 9.

#### 4. Claims 6 and 7

Claims 6 and 7 stand rejected as allegedly being unpatentable over Chung '963 and Downs '618 and further in view of Yamagata. Claims 6 and 7 are canceled, thereby obviating the rejection. Applicant respectfully requests withdrawal of the rejection of claims 6 and 7.

#### 5. Claims 11-14

Claims 11-14 stand rejected as allegedly being unpatentable over Chung '963, Katayama '212, and Downs '618 and further in view of Gibson '596.

As set forth above in the discussion of claim 9, Chung '963, Downs '618, and Katayama '212 do not substantiate obviousness because they do not include all the recited features of claim 9. Gibson '596 and all other art of record do not cure the deficiency of

---

<sup>15</sup> Note 5.

<sup>16</sup> *Id.*

Chung '963, Downs '618, and Katayama '212 in this regard. Thus, claims 11-14 are allowable at least for the reason that they depend from an allowable independent claim and recite additional features. Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 11-14.

### **Conclusion**

This is a complete response to the Office Action mailed November 26, 2007. Applicant respectfully requests the passage of all the pending claims to allowance.

Applicant has also submitted herewith a request for telephone interview. Absent allowance, Applicant respectfully requests the opportunity for a telephone interview in order to facilitate a mutual understanding as to what is claimed and what the cited references disclose to facilitate progress on the merits in this case.

The Office is invited to contact the undersigned should any questions arise concerning this response or any other matter in this case.

Respectfully submitted,  
By:   
Mitchell K. McCarthy, Registration No. 38,794  
McCarthy Law Group  
5830 Northwest Expressway, #353  
Oklahoma City, Oklahoma 73132  
Telephone: 877.654.6652  
[www.mccarthyiplaw.com](http://www.mccarthyiplaw.com)